

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested. Claims 1, 4-9, 12-17, 20-25, and 28-32 are pending in the present application.

In the outstanding Office Action, Claims 1, 4-9, 12-17, 20-25, and 28-32 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,884,056 to Steele in view of EP 1 024 444 A2 to Hori.

As previously noted in the paper filed Nov. 6, 2006, pending Claim 1 is directed to an apparatus for extracting still pictures from a picture stream including both scene-changing still pictures and non-scene-changing still pictures. Claim 1 defines a transmission sequence determining unit configured to determine a transmission sequence to transmit the still pictures in one series, which is different than the sequence of the still pictures in the picture stream such that

(a) each of the scene-changing still pictures of the transmission sequence are transmitted prior to the non-scene-changing still pictures, and

(b) one of the non-scene changing still pictures positioned in a middle of a largest interval between scene-changing still pictures included in the picture stream is first transmitted after the scene-changing still pictures are transmitted.

This sequencing feature addresses the problems discussed in the February 10, 2006 amendment and identified in the specification at page 7, lines 20-25 and page 7, lines 9-12. Further, as a consequence of the present invention, non-scene changing still pictures are sent without selection and request by a user while the user is browsing the pictures received. Therefore, the user need not continue either the selection or request process.

Each remaining independent claim recites the sequencing feature, such that the claimed sequencing feature is included in each pending claim.

The outstanding Office Action relies on a combination of teachings provided by Steele and Hori as rendering the claimed invention, including the noted sequencing feature, as obvious. The outstanding Office Action states the finding that both Steel and Hori teach that scene-changing still pictures are important.¹ However, the outstanding Office Action acknowledges deficiencies in the applied references as follows:

Steele does not disclose expressly that the still pictures also contain non-scene-changing still pictures; and the determining unit determines the transmission sequence to be such (a) that the scene-changing still pictures are transmitted prior to the non-scene-changing still pictures and (b) that one of the non-scene-changing still pictures positioned in a middle of a largest interval between scene-changing still pictures included in the picture stream is first transmitted after the scene-change still pictures are transmitted.² ...

Steele in view of Hori does not disclose expressly that the determining unit determines the transmission sequence such (b) that one of the non-scene changing still pictures positioned in a middle of a largest interval between scene-changing still pictures is first transmitted after the scene-changing still pictures are transmitted.³

In light of these acknowledged deficiencies in the cited prior art, it is respectfully submitted that it is only through a hindsight reconstruction of the claimed invention that any semblance of the claimed invention, and particularly the claimed sequencing feature, can be gleaned from these references.

In particular, Steele teaches transmission of scenes which are temporally randomly spaced, or are temporally evenly spaced still pictures, or preferably selected at scene cut points.⁴ Steele fails to teach transmission of a combination of scene cut points with other scenes,⁵ and thus Steele cannot teach an order of any such transmission involving a differentiation between scene cut images and non-scene cut images. On the contrary, an

¹ Official Action, page 4, lines 6-9 with respect to Steele, and page 4, third full paragraph with respect to Hori.

² Id., page 4, second full paragraph.

³ Id. page 5, first full paragraph.

⁴ Steele, column 6, lines 26-34.

⁵ Steele at column 9, lines 39-45 does not teach this feature, but merely indicates at column 9, lines 50-52 that the server "selects a new set of key frames" which are presumably scene cut frames identified in Steele as being "key frames."

unbiased reading of Steele quite clearly indicates that Steele teaches transmission of scene cuts in the order in which they appear within a selected “video object,” as apparent from the illustration in Figure 7 of a video region 54 showing where in the video object the selected and displayed scenes appear. In that regard, Steele notes,

To further assist the user in getting a sense of where the displayed thumbnail images occur in the video object, a representation of the video object in its entirety, and of the portion covered by the displayed thumbnail images, is given. In FIG. 7, this is shown as a slider bar 54. The slider bar 54 is shown horizontally, but can be in any suitable configuration, preferably a configuration which comports well with user intuition. The entire horizontal length of the slider bar 54 represents the total duration [sic] of the video object, and a marker 56 represents the relative location, within the video object, of the displayed thumbnail images. Preferably, the marker 56 has a width, relative to the width of the entire slider bar 54, which reflects the portion of the entire video data object covered by all of the displayed representations.⁶

Thus, Steele teaches a display designed to “assist the user in getting a sense of where the displayed thumbnail images occur in the video object” which is incompatible with a non-temporally ordered sequence, as per the claimed sequence. In other words, Steele not only fails to teach, as acknowledged in the outstanding Office Action, a transmission sequence in which (a) each of the scene-changing still pictures of the transmission sequence are transmitted **prior to** the non-scene-changing still pictures, but in fact teaches away from such a sequence since Steele teaches display of scenes in the temporal order they appear in the selected video object. It is respectfully submitted that this alone is sufficient to patentably define over Steele.

Indisputably, as also acknowledged in the outstanding Office Action, Steele fails also to teach (b) one of the non-scene changing still pictures positioned in a middle of a largest interval between scene-changing still pictures included in the picture stream is first transmitted after the scene-changing still pictures are transmitted, which would be inapposite to the temporally ordered display shown in the Steele Figure 7. In fact, contrary to the

⁶ Id. column 8, lines 24-37.

finding stated at page 5, line 15 of the outstanding Office Action, Steele at column 9, lines 39-45 does not per se teach selection and transmission of non-scene-changing still pictures in the interval between scene-change still pictures, but instead teaches selection of scenes temporally following a selected thumbnail (scene cut) image. Steele is indisputably silent as to the length of intervals between scene cuts, the largest interval between scene cuts, and the display of scenes positioned in a middle of a largest interval between scene cuts.

Accordingly, it is respectfully submitted that Steele is deficient in a number of ways and clearly fails to obviate the claimed invention.

The outstanding Office Action states the finding that Hori discloses a collection of thumbnail still pictures which includes scene-changing still pictures and non-scene-changing (“arbitrary time intervals”) still pictures, and that Hori like Steele teaches that scene-changing still pictures are more important than non-scene changing still pictures.⁷ Even if that is true, that does not provide a basis for obviating the claimed invention, especially where Hori, like Steele, teaches a thumbnail retrieval at column 13, lines 11-50, Figure 7, in which thumbnail frames are acquired sequentially (step S33, Figure 7) and “in order one by one from the temporal/spatial thumbnail meta-data 102” (column 13, lines 19-21). In effect, Hori reinforces the temporal sequence ordering of Steele, and like Steele, therefore teaches away from the claimed sequence portion (a) above noted. Once again, this alone is sufficient to patentably define over the combined teachings of Steele and Hori.

Moreover, Hori clearly does not teach transmission of non-scene-changing still pictures after scene-change still pictures, and like Steele is indisputably silent as to the length of intervals between scene cuts, the largest interval between scene cuts, and the display of scenes positioned in a middle of a largest interval between scene cuts after display of scene cuts (scene-change-still-pictures). Accordingly, it is respectfully submitted that Hori likewise

⁷ Official Action, page 4, third full paragraph.

is deficient with respect to the claimed sequence portion (b) and clearly fails to obviate the claimed invention even when considered with Steele.

The outstanding Office Action seems to ignore these deficiencies in the references, stating,

... Since the scene-changing still pictures are clearly more important, as taught by both Steele and Hori, one of ordinary skill in the art at the time of the invention would obviously transmit the scene-changing still pictures before the non-scene-changing still pictures. ...⁸

This finding ignores the fact that both Hori and Steele teach sequences which are temporally ordered, and not per se based on an order of importance. The “motivation” offered in the outstanding Office Action, i.e., to provide the user with additional data regarding a particular scene or scenes within the video the user is considering downloading, is likewise speculative and unsupported by any corresponding teaching in the references.

The outstanding Office Action then further acknowledges that “Steele in view of Hori does not disclose expressly that the determining unit determines the transmission sequence such (b) that one of the non-scene-changing still pictures positioned in a middle of a largest interval between scene-changing still pictures ... is first transmitted after the scene-changing still pictures are transmitted.”⁹ The Office Action, without citation to any prior art teaching, finds that this claimed feature not taught by the references is design choice.¹⁰ However, once again, the outstanding Office Action misses the point that both Steele and Hori teach temporal ordering, contrary to the ordering defined by portion (a) and portion (b) of the claimed transmission sequence.

While on the one hand relying on a finding of design choice to support the obviousness rejection, in the same paragraph of the outstanding Office Action, the Office

⁸ Id., paragraph linking pages 4- 5.

⁹ Id., page 5, lines 3-6.

¹⁰ Id. page 5, lines 7-11.

Action states,

... A natural place for a user to select a non-scene-changing picture would be between the two scene-changing still pictures corresponding the largest time interval since such a selection would better narrow down the video, **giving fuller information to the user....**¹¹ [Emphasis added.]

Remarkably, the Office Action thus acknowledges an advantage, not taught in the prior art, of an aspect of Applicants' invention not taught in the prior art, yet gives Applicants no credit. Even then, it should be understood, that the "fuller information given to the user" according to the claimed invention is given immediately after transmission of scene-changing pictures, not temporally mixed with scene-change pictures as would be taught by the prior art if the prior art taught the "fuller information," which it does not. Further, the "fuller information" is the frame in the middle of the largest time interval between scene changes, another claimed feature nowhere mentioned or contemplated in the prior art.

Reiterating, the claimed transmission sequence is ordered to give the user the most relevant information in an order of importance not taught by the prior art. The claimed invention departs from the prior art temporal ordering, and further advances the art by identifying "fuller information" to the user¹² and where to place the "fuller information."¹³ Since these feature of the claimed invention are clearly not taught by the cited prior art and are in fact contrary to the teachings of the cited prior art, it is respectfully submitted that the outstanding rejection on the merits is traversed.

Applicants further take issue with the outstanding ground for rejection which is based on taking of judicial notice. MPEP 2143.03 states "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art," yet no prior art is cited in regard to specific claim elements as above explained. The U.S.

¹¹ Id. page 5, lines 17-19.

¹² That is, largest interval between scene change pictures and the frame in the middle of the largest interval between scene change pictures.

¹³ That is, in an order of importance after transmission of the scene change pictures.

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Supreme Court requires "substantial evidence" in support of finding of obviousness.

Dickinson v. Zurko, US 50 USPQ2d 1930 (U.S. SupCt 1999). The Federal Circuit has held that "the USPTO's assessment that such a feature is "basic knowledge" or "common sense" is not substantial evidence." In re Zurko, 59 USPQ2d 1693 (Fed. Cir. 2001). Accordingly, the outstanding rejection on the merits is further traversed as not being based on substantial evidence.

Consequently, in view of the above comments, the pending claims are believe to be patentably distinguishing over the cited prior art and in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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